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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,320	06/02/2005	Akihiro Tada	TOYA107.007APC	3197
20995 7590 01/27/2009 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER SZNAIDMAN, MARCOS L				
ART UNIT		PAPER NUMBER		
1612				
NOTIFICATION DATE		DELIVERY MODE		
01/27/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary

Application No.

10/537,320

Applicant(s)

TADA ET AL.

Examiner

MARCOS SZNAIDMAN

Art Unit

1612

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to applicant's reply filed on October 28, 2008

Status of Claims

Cancellation of claims 1-6 and 10-11, amendment of claims 7 and 9, and addition of new claims 12-13 is acknowledged

Claims 7-9, and 12-13 are currently pending and are the subject of this office action.

Claims 7-9 and 12-13 are presently under examination.

Priority

The present application is a 371 of PCT/JP03/15267 filed on 11/28/2003, and claims priority to foreign application JAPAN 2002-350733 filed on 12/03/2002.

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a certified English translation of the foreign application must be submitted in reply to this action. 37 CFR 41.154(b) and 41.202(e).

Failure to provide a certified translation may result in no benefit being accorded for the non-English application.

Rejections and/or Objections and Response to Arguments

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated

Art Unit: 1612

(Maintained Rejections and/or Objections) or newly applied (New Rejections and/or Objections, Necessitated by Amendment or New Rejections and/or Objections not Necessitated by Amendment). They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 103 (Maintained Rejection)

Claims 7-9 and new claims 12-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et. al. (EP 1147764, cited by applicant, cited in prior office action).

The reasons for this rejection have been provided in the previous office action dated July 31, 2008, the text of which is incorporated by reference herein.

Applicant's arguments have been fully considered but are not persuasive.

Applicant argues that the new limitation "an individual in need thereof" must be accorded weight in the determination of patentability. In the present case, a person in need of inhibition of elongation of melanocytic dendrites is not necessarily the same person as a person in need of a combination of whitening effect, vitalizing the skin and preventing wrinkles as taught by Ishida in paragraph [0006]. Applicant further explains that the compounds of the instant application inhibit elongation of melanocytic dendrites as opposed to the compounds of Ishida, which inhibit melanin production by inhibiting tyrosine kinases. The later compounds, according to applicant are less effective or not effective at all in treating dyschromatosis. Accordingly, a person in need of a skin

Art Unit: 1612

treatment "whereby elongation of melanocytic dendrites is inhibited" would not turn to the compounds of the disclosure of Ishida, because there is no indication in Ishida that the compounds disclosed by Ishida are useful to inhibit dendrite elongation.

Examiner's response: First: it is not clear which individuals are encompassed by the limitation: "individuals in need for inhibition of melanocytic dendrites", so it is not clear which population it is aimed at with this treatment. Second: what it is claimed is a method for inhibiting elongation of melanocytic dendrites with compounds of formula I (see claim 1) and more specifically Centaureidin (see claim 8). These compounds are structurally anticipated or made obvious by the compounds of Ishida (see general formula I on page 3) and they are being used for the treatment of skin problems like skin darkening, wrinkles, etc. Since dyschromatosis is also a skin disease associated with skin darkening or anomalous skin pigmentation, it would be obvious to the skilled in the art to treat to treat dyschromatosis (and hence inhibit the elongation of melanocytic dendrites) with the compounds disclosed by Ishida, even though Ishida is silent regarding the mechanism of action of these compounds. Also, applicant has already admitted (see page 6 of the last reply, third paragraph), that some of these compounds have already been used in the treatment of dyschromatosis although with not as much effectiveness as the compounds of the instant application.

The new claims 12 and 13 add new limitations: wherein the compounds are used in an amount of 0.005 to 5% by weight (claim 12) and wherein the skin preparation for external is cosmetic. For claims 12 and 13 Ishida further teaches that the cosmetic composition of the present invention includes 0.00005 to 10% by weight of the compounds of formula I.

Conclusion.

No claims are allowed.

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MARCOS SZNAIDMAN** whose telephone number is (571)270-3498. The examiner can normally be reached on **Monday through Thursday 8 AM to 6 PM.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Frederick F. Krass** can be reached on **571 272-0580**. The fax phone

Art Unit: 1612

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARCOS SZNAIDMAN/
Examiner, Art Unit 1612
January 15, 2008

/Frederick Krass/

Supervisory Patent Examiner, Art Unit 1612